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| 09/903,706 | 07/13/2001 | Masamichi Ito | 03500.012551.1 | 1058 |
| 5514 | 7590 | 12/30/2008 | EXAMINER | |
| FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112 | | | NEURAUTER, GEORGE C | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/903,706 | ITO ET AL. | |
| | Examiner | Art Unit | |
| | George C. Neurauter, Jr. | 2443 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 16 October 2008.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 30,32-34 and 36-41 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 30,32-34 and 36-41 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims 30, 32-34, and 36-41 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 16 October 2008 have been fully considered but they are not persuasive.

The Applicant argues the "Olympus" reference fails to teach or suggest the limitations of claims 30 and 34. The Examiner respectfully disagrees in view of the previous Office Action. Currently amended claims 30 and 34 now recite the subject matter previously recited in canceled claims 31 and 35. Claims 31 and 35 were rejected under 35 USC 103(a) as being unpatentable over "Olympus" in view of Saegusa based on the combined teachings of these references. Since the Applicant failed to make any remarks in the current response regarding the combined teachings of these references and how they were applied to canceled claims 31 and 35, the Examiner submits that the combined teachings of "Olympus" and Saegusa do in fact teach or suggest amended claims 30 and 34.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 30, 32, 34, 36, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Olympus Digital Vision D-320L D-220L Digital Camera Instructions" ("Olympus") in view of US Patent 6 442 349 B1 to Saegusa et al.

Regarding claim 30, "Olympus" discloses a method of controlling a data communication apparatus, the method comprising the steps of:

controlling the data communication apparatus to send image data selected by a user to a printer via a serial bus, the image data being sent from the data communication apparatus in response to entering a send instruction into the data

communication apparatus; (see at least page 128, specifically "By connecting the camera to the P-300U printer with the exclusive cable, pictures can be directly sent from the camera (3) Select the picture you want to print...")

controlling the data communication apparatus to inhibit, invalidate, or ignore ("disable") a predetermined user instruction while the image data is being sent to the printer and while the image data is being printed by the printer, (see at least page 128, specifically "The Condition indicator LED lights while printing, and other operations are disabled") (user instructions are described throughout the reference including the claimed send instruction as shown in "Olympus")

"Olympus" did not expressly disclose controlling the data communication apparatus to stop inhibiting, invalidating, or ignoring the predetermined user instruction in response to disconnecting the data communication apparatus from the serial bus while the image data is being sent to the printer and while the image data is being printed by the printer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to stop the inhibition, invalidation, or ignoring the predetermined user instruction when the data communication apparatus is disconnected by the serial bus during printing of the image data since one of ordinary skill in the art would have recognized that, when the apparatus is disconnected from the printer via the serial bus, image data is no longer able to be sent to the printer from the apparatus, effectively stopping the printing of the image data. As also taught in "Olympus", the data communication apparatus contains a lighted indication only while the apparatus is

currently printing and operations are disabled (see page 128, specifically the “condition indicator LED”). One of ordinary skill would have been able to determine from these teachings that, when the indication is no longer lit such as in a situation where the serial bus connection is disconnected such as by disconnection of the serial bus cable (see also page 128 which shows the cable that attaches the data communication apparatus to the printer denoted “P-300U”), printing is no longer occurring and the indication light would also be no longer be lit, thus also no longer disabling the operations of the data communication apparatus. Therefore, one of ordinary skill would have found it obvious in view of the teachings of “Olympus” that the data communication apparatus would stop inhibiting, invalidating, or ignoring the predetermined user instruction in response to disconnecting the data communication apparatus from the serial bus while the image data is being sent to the printer and while the image data is being printed by the printer.

“Olympus” further did not expressly disclose further comprising the step of controlling the data communication apparatus to notify a user with a warning message in response to entering the predetermined user instruction into the data communication apparatus while the predetermined user instruction is being inhibited, invalidated, or ignored, however, Saegusa does disclose this limitation in the context of providing instructions to a user on a data communication apparatus (see at least column 1, lines 49 and 52-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since Saegusa discloses that notifying a user with a warning message prevents the user from entering

commands when such an operation would be undesirable (see column 1, lines 52-56). In view of these specific advantages and that the references are directed to providing instructions to a user on a data communication apparatus, one of Ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 34 is also rejected since this claim recites substantially the same limitations as recited in claim 30.

Regarding claim 32, “Olympus” and Saegusa disclose the method according to claim 30.

“Olympus” discloses wherein the data communication apparatus is an apparatus including at least one video recording unit and at least one camera unit. (see references within “Olympus” to “camera”)

Saegusa also discloses this limitation (see references within Saegusa to “camera”).

Claim 36 is also rejected since this claim recites substantially as recited in claim 32.

Regarding claim 38, “Olympus” and Saegusa disclosed a method according to claim 30.

“Olympus” disclosed wherein the predetermined user instruction includes an instruction to change a mode of the data communication apparatus to another mode.

(see at least page 128, specifically "The Condition indicator LED lights while printing, and other operations are disabled"; see also at least pages 70-94 and 128-136 for examples of predetermined user instructions for changing "modes")

Claim 39 is also rejected since this claim recites substantially the same limitations as recited in claim 38.

Regarding claim 40, "Olympus" disclosed a method according to claim 30. "Olympus" did not expressly disclose controlling the data communication apparatus to stop inhibiting, invalidating, or ignoring the predetermined user instruction in response to receiving notice from the printer that the image data is printed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to stop the inhibition, invalidation, or ignoring the predetermined user instruction when the data communication apparatus is disconnected by the serial bus during printing of the image data since one of ordinary skill in the art would have recognized that, when the apparatus is disconnected from the printer via the serial bus, image data is no longer able to be sent to the printer from the apparatus, effectively stopping the printing of the image data. As also taught in "Olympus", the data communication apparatus contains an lighted indication only while the apparatus is currently printing and operations are disabled (see page 128, specifically the "condition indicator LED"). One of ordinary skill would have been able to determine from these teachings that, when the indication is no longer lit such as in a situation where the printer has completed printing the image data, printing is no longer occurring and the indication light would also be no longer be lit, thus also no longer disabling the

operations of the data communication apparatus. One of ordinary skill would also recognize that the printer must send an indication that the image data has been printed, otherwise, an illogical situation would occur in that the data communication apparatus would never be aware when the printer has completed printing and would stay in a printing state indefinitely, which would cause the data communication apparatus to become nonfunctional. Therefore, it would have been obvious to one of ordinary skill in the art in view of the teachings of "Olympus" that the data communication apparatus would stop inhibiting, invalidating, or ignoring the predetermined user instruction in response to receiving notice from the printer that the image data is printed.

Claim 41 is also rejected since this claim recites a data communication apparatus that contains substantially the same limitations as recited in claim 40.

Claims 33 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Olympus" and Saegusa as applied to claims 30 and 34 above, and further in view of "IEEE 1394: A Ubiquitous Bus" ("IEEE 1394").

Regarding claim 33, "Olympus" and Saegusa disclose the method of claim 30. "Olympus" and Saegusa do not expressly disclose wherein the serial bus conforms to IEEE 1394 standards, however, "IEEE 1394" does disclose such a communication bus in the context of image transferring (page 1, specifically "Its scalable architecture and flexible peer-to-peer topology make 1394 ideal for connecting devices from computers and hard drives, to digital audio and video hardware"; page 2, specifically "Broad markets for 1394 digital data transport include:...audio, image, and video products for multimedia, printer and scanner products for imaging...")

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of these references since “IEEE 1394” discloses that using the IEEE 1394 bus allows for a universal I/O connection and a scalable architecture between devices such as printers and imaging devices (see page 1). In view of these specific advantages and that the references are directed transferring image data between nodes over a communication bus, one of ordinary skill would have been motivated to combine these references and would have considered them to be analogous to one another based on their related fields of endeavor, which would lead one of ordinary skill to reasonably expect a successful combination of the teachings.

Claim 37 is also rejected since this claim recites substantially the same limitations as recited in claim 33.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571)272-3918. The examiner can normally be reached on the hours between 8:30am-5:00pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on 571-272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George C. Neurauter, Jr./
Primary Examiner, Art Unit 2443